

With regard to claims 1-3 and 7, the Examiner states that Smith shows a spacer 14 “having a width sufficient to rest flush against the exposed portion of one of the shingles without overlapping adjacent rows.” This is simply not true since Figs. 3A and 3B of Smith show that spacers 14: a) do not rest flush upon wood shakes 22 but are elevated above shakes 22 by both wood strips 21 and polystyrene risers 24, and b) do overlap four adjacent rows of shakes 22. Thus, the spacer of Smith is incapable of functioning in the same manner as Applicant’s spacer.

The Examiner further states that Smith teaches the construction of a spacer formed of polyethylene as set forth in claim 2. Smith, however, does nothing of the sort. Smith teaches a spacer formed of *expanded polystyrene* and having different physical properties than polyethylene. Thus, Smith does not meet the limitations of claim 2.

The Examiner states that Smith’s spacer “can be formed into a roll for convenient storage and transport prior to use” as set forth in claim 3. Expanded polystyrene, used in Smith’s preferred spacer, is stiff and not easily rolled. Rolling is made even more difficult by the unusual dimensions that Smith gives to his spacer. Smith’s spacer is fat, being triangular or quadrilateral cross-section and tapering from 1.5625” to 0.5625” over a width of 12”. Furthermore, Smith’s spacer is short, being only 48” in length. Thus, as shown in Fig. 6, Smith’s spacers are shown bound together in larger blocks, without rolling, for shipping and storage. Smith’s spacer is seen to be incapable of rolling and meeting claim 3.

Should the Examiner choose to maintain his position the Smith’s spacer is somehow “inherently capable” of being rolled, it is requested that some teaching from the prior art be presented in support of this. At present, it is clear that Smith teaches away from rolling and the Applicant’s spacer.

In regard to claim 7, the Examiner opines that Smith shows each and every one of the claimed elements. It is unclear, however, whether Smith discloses a joist and a deck as claimed

since the Examiner provides no call-outs from Smith's drawings. Certainly, nothing like the claimed underlayment is seen in Smith's drawings or is described in his specification. Also, there is no "corrugated panel 916," to which the Examiner refers, in Smith's drawings. Finally, it does not appear that several of the elements of Smith's roof are positioned "atop," i.e., on the top of, another as claimed. For example, Smith shows no resilient spacer positioned on the top of one row of shingles and projecting above adjacent rows. Because Smith does not show all of elements of the roof of claim 7, the rejection thereof under 35 U.S.C. § 102(e) must fail and must be withdrawn.

Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith. Here, the Examiner opines that Smith shows all of the claim limitations except for the spacer having a width of about 3" and a height of about  $\frac{1}{4}$ " and that it would have been obvious to provide the spacer of Smith with such dimensions. The Applicant notes that one of ordinary skill in the art would not choose to make Smith's spacer with a height of  $\frac{1}{4}$ ".

It goes without saying that if Smith's spacer requires some modification in order to meet claim 4 and such a modification destroys the function of Smith's spacer, one of ordinary skill in the art would not have found a reason to make the suggested modification. Assuming, for the sake of argument, that some teaching exists in Smith to make the spacer about  $\frac{1}{4}$ " in height over its length and width, then the wedge-shape of Smith's spacer would be lost. Without a wedge-shape, Smith's spacers cannot span from the top of one batten 20 to the bottom of an adjacent batten 20 to accommodate the terracing of roof panels 16. Thus, a spacer with a set height of  $\frac{1}{4}$ " is clearly incompatible with the requirement of Smith that spacer height be variable across the width of the spacer. It is respectfully submitted, then, that one of ordinary skill in the art would not have made the modification of Smith suggested by the Examiner.

Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith. It is said by the Examiner that Smith shows all of the claimed limitations making the claim obvious. Ignoring the fact that if all of the limitations of claim 5 are shown by Smith, then claim 5 should be anticipated rather than be made obvious by Smith, a careful review of Smith, however, indicates that all of the limitations are not shown.

Claim 5 requires that a first strip of resilient foam be positioned atop one row of asphalt shingles of a roof, and that a second strip of resilient foam be positioned atop another row of asphalt shingles, and that *a corrugated metal panel be positioned atop the first strip of resilient foam and the second strip of resilient foam*, and a penetrating fastener be driven through the corrugated metal panel. The claimed method provides support for a single corrugated panel above asphalt shingles by a pair of spaced-apart foam strips. Smith, on the other hand, fails to show asphalt shingles (wooden shakes are shown) as well as a panel positioned "upon the tops of" (Applicant's definition of "atop") more than one foam strip or spacer as claimed. Thus, the rejection of claim 5 should be withdrawn.

Accordingly, it is respectfully submitted that this application is in condition to be passed to issue. If such is not determined to be the case, however, the Examiner is respectfully requested to call the undersigned attorney at the number given below in an effort to satisfactorily conclude the prosecution of this application.

Respectfully submitted,



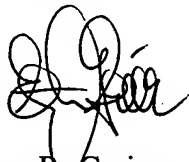
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A handwritten signature in black ink, appearing to read "Stephen R. Greiner", with a stylized flourish at the end.

Stephen R. Greiner  
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